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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,885	01/18/2005	Ki Soon Ahn	9983.145USWO	8847
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MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER JACOB, AJITH	
			ART UNIT 2161	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/521,885	Applicant(s) AHN, KI SOON	
	Examiner Ajith Jacob	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,14-18 and 20 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-3,5,14-18 and 20 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>1/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 6, 2007 has been entered.

Claim Objections

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Computer readable medium should read in the specification as having hardware for claim 14.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 5 and 15-17 are directed towards software, *per se*. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. Descriptive material can be characterized as either

"functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

4. Claim 1 comprises of a system, but do not specify a physical piece of hardware to fulfill the claim, and thus have been rejected.

5. Claims 2-3, 5 and 15-17 does not solve any of the non-statutory deficiencies of claim 1, and thus are rejected for the reasons stated above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3, 5, 14-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Eder et al. (US 2001/0034628 A1).

For claim 1, Eder et al. teaches:

A consulting system-of the type which provides a consulting service of a specific field to a user across a network [0047], said consulting system comprising:
a database system comprising: a plurality of problem objects, each of the problem objects having an identifier, an execution condition, questions which will be given to the user [identification of the objects, execution condition through prior value comparison and financial data assignment, and plurality of questions presented to user, Figure 5A], and answers which will be selected by the user as properties of the problem objects [answers provided by user for each definition, Figure 5A]; [.,.] and a plurality of unit objects, each unit having an answer script for reflecting a result of a series of processes and including at least one of the plurality of problem objects [system with multiple tables and ability to complete necessary calculations, 0048], the plurality of unit objects including a first unit object [prompting and calculations done within one object, Figure 5A], wherein rules between the objects are defined depending on corresponding properties of the objects and wherein the first unit object includes as a property a compulsory condition which precedes the execution condition of the plurality of problem objects [existence of a condition that is executed before the problem object, Figure 5A, 204]; and a service component for providing an interface screen for the consulting service to the user via the network [display interface to provide user with information over network, 0047], and for supplying personalized final answers to the user by

performing the answer script if the user answers the questions supplied by the rules [extract data from database after user input, 0047], wherein the service component executes the plurality of problem objects in a sequence according to the identifiers of the problem objects which have been input as a property of the first unit object, and wherein the execution condition determines whether the problem object is executed or not [conditional questions to determine whether to prompt for input, Figure 5A, 204].

For claim 2, Eder et al. teaches:

The system according to claim 1, wherein the first unit object includes a second unit object. Eder et al. teaches multiple definitions that account for multiple unit objects [Figure 5A, 903-905].

For claim 3, Eder et al. teaches:

The system according to claim 2, wherein the second unit object includes a property for a condition that causes the second unit object to be executed upon execution of the first unit object. Eder et al. teaches the ending of the first unit object with a prompt for the second unit object [Figure 5A].

For claim 5, Eder et al. teaches:

The system according to claim 1, wherein the service component operates according to a protocol for providing contents to at least one or more equipments selected from the group, comprising: a personal computer accessible to the network, a PDA (Personal Digital Assistant), a wireless terminal, a wire/wireless telephone set and an internet phone [computer system comprising of a client computer and an application server computer that are interconnected via a network, 0049].

Claim 14 is a computer readable medium of claim 1. Eder et al. teaches the limitations of claim 1 for the reasons stated above.

Claim 15 is a method of claim 2. Eder et al. teaches the limitations of claim 2 for the reasons stated above.

Claim 16 is a method of claim 3. Eder et al. teaches the limitations of claim 3 for the reasons stated above.

Claim 17 is a method of claim 5. Eder et al. teaches the limitations of claim 5 for the reasons stated above.

Claim 18 is a method of claim 1. Eder et al. teaches the limitations of claim 1 for the reasons stated above.

For claim 20, Eder et al. teaches:

The method according to claim 18, wherein the first unit object further includes a second unit object and wherein the second unit object includes a property for a condition that causes the second unit object to be executed upon execution of the first unit object. Eder et al. teaches a function in between the two unit objects that is used as a condition to execute the second unit upon the execution of the first [Figure 5A, 209].

Response to Arguments

8. Applicant's arguments filed October 31, 2007 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's argument.

Amendments to the claims have overcome the 112 2nd paragraph rejections.

Applicant argues that Eder et al. (US 2001/0034628 A1) fails to disclose a service component that executes the plurality of problem objects in a sequence

according to the identifiers of the problem objects which have been input as a property of the first unit object. Eder et al. clearly teaches the existence of a first unit object [202] that compares itself to multiple problem objects [205-208] as part of a component [Figure 5A]. The problem objects are executed in sequence after the comparison. Applicant also argues the Eder et al. fails to teach a first unit object including as a property a compulsory condition which precedes the execution condition of the plurality of problem objects. Eder et al. again clearly teaches the comparison condition [204] between the first object and the plurality of problem objects as recited by the claim.

In light of the forgoing arguments, the 35 U.S.C. 102 rejections are hereby sustained.

Conclusion

9. The Examiner requests, in response to this Office action, that support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s) in the specification and/or drawing figure(s). This will assist the Examiner in prosecuting the application.

When responding to this Office action, Applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections See 37 CFR 1.111(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajith Jacob whose telephone number is 571-270-1763. The examiner can normally be reached on M-F 7:30-5:00 EST, Every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

1/22/2008

AJ

AJ
Patent Examiner

Kpham

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PRIMARY EXAMINER